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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,882	02/08/2002	Kristin A. McCloskey	WMO 3E4	8759

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-9

Office Action Summary

Application No.

10/071,882

Applicant(s)

MCCLOSKEY ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-18 is/are allowed.
- 6) ☒ Claim(s) 1,5-11, and 19 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sway (U.S. Pat. No. 3,921,801).

Sway discloses an apparatus comprising a base platform (30) having an alignment member (36), and a plurality molding trays including an alignment structures configured to engage the alignment member of the base platform (see figure 18, and column 3, lines 58-61). Sway further discloses the molding trays to be configured for vertical stacking one on top of another and vertically removable from the base platform (see figure 18). The arrangement of the trays is such that they could be rotated about a central axis (see figure 18). Sway also discloses the one mold tray to include a mold design cavity including an animal (44).

It is noted that the claims recite an intended use of the apparatus, specifically to be used as a children's toy for making confections. However, it is well settled that the intended use of the apparatus is not germane to the issue of

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patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963). In the instant case, the design of the apparatus of Sway is such that the mold cavities could be used in a confection molding process, and therefore meets the limitations of the apparatus claims.

3. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by McBride (U.S. Pat. No. 5,458,243).

McBride discloses an apparatus comprising a base platform (18) having a vertical alignment member (16) located concentric with a central axis, a plurality of stackable rotatable trays (12) including alignment apertures configured to engage the vertical alignment member of the base platform as the trays are stacked, and wherein the trays are configured could be rotated around the central axis (see figure 3).

As noted above, the intended use recited in apparatus claims is not germane to the issue of patentability of the apparatus. The apparatus taught by McBride, having molding trays (12), could be used in a molding operation with a confection mixture, and thus anticipates all of the apparatus claims of the instant application.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to

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point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sway.

Sway discloses the apparatus as described above, including mold trays having the design cavity with the shape of an animal. Sway further discloses the apparatus to have different design cavities depending on the desired product shape to be molded (see figures 8-11 and 19). Although Sway does not teach the animal shape to be an earthworm or bear, or for the design to be a ring shape, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the shape of the cavity disclosed by Sway to include such things as an earthworm, bear, or ring as desired to create a product of such a shape given Sway's teaching of the manipulation of the mold cavity design.

8. Applicant's arguments filed April 2, 2003 have been fully considered but they are not persuasive.

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With respect to amended claim 1, Applicant asserts that the claim patentably distinguished over the references of record. This claim, with amended limitations, is still anticipated by Sway as described above.

With respect to claim 19, Applicant states that the structure recited in the claim includes elements not shown by McBride. However, Applicant fails to specifically point out any structures that are not shown in McBride. McBride does disclose an apparatus anticipating all of the limitations recited in claim 19 as described above.

9. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 15-18 are allowed. See the reasons for indicating allowable subject matter in the previous Office Action.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action,

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and 703-872-9311 for responses to final actions. The unofficial
fax phone number is (703) 305-3602.



Donald Heckenberg
June 5, 2003



JAMES P. MACKEY
PRIMARY EXAMINER
6/9/03